



UNITED STATES PATENT AND TRADEMARK OFFICE

mn
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,249	03/13/2001	Masaaki Mori	1095.1171/JDH	9135
21171	7590	07/11/2007	EXAMINER	
STAAS & HALSEY LLP			BARQADLE, YASIN M	
SUITE 700			ART UNIT	PAPER NUMBER
1201 NEW YORK AVENUE, N.W.			2153	
WASHINGTON, DC 20005			MAIL DATE	DELIVERY MODE
			07/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/804,249	Applicant(s) MORI ET AL.	
	Examiner Yasin M. Barqadle	Art Unit 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1, and 3-6.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

Response to Amendment

1. The amendment filed on April 12, 2007 has been fully considered but are not deemed persuasive in view of the new grounds of rejection and the response to arguments below.

- Claims 1,5 and 6 are amended.
- Claims 7,8,10,11 and 13-14 are cancelled.
- Claims 1, and 3-6 are presented for examination.

Response to Arguments

2. To overcome the 112 rejections in the last Office Action, Applicant refers to fig. 6C, fig. 10C and page 22; line 1-9 and page 22, lines 25 to page 23 lines 8. However, after careful reading on pages 22, line 1 to page 23 lines 8 and fig. 6C and 10C. Examiner could not find the teaching of adding a second user account and second password to the electronic mail as claimed and argued by the Applicant. See page 5 of the remarks "As described at page 22, lines 1-9, the second user account and the second password" are added to the electronic mail. Further, at page 22, line 25 to page 23, line 8, discusses, logging in the FTP server 162 by the use of the "second user account and the second password" added to the "electronic mail". At most the cited portion of page 22 and 23 logging to a server to retrieve email attachment stored therein by using user account and password. See page 23, lines 2-8 "A user knows the store server, store directory, log-in account, and password, being the transfer management information 103e, as store location information from the mail body. He/she can refer to the attached file by logging in the FTP server 162 by the use of these pieces of information" Hence the cited portion teaches merely a user accessing the attachment storage server (FTP server 162) using a known account and password.

Applicant continues to argue "what is set in the transfer management information 101e shown in Fig. 6C, is "the first user account and the first password" to be used to access the FTP server 161.

Art Unit: 2153

Further, on the other hand, what are set in the transfer management information 103e of FIG. 10C are the "second user account and the second password" to be used to access the FTP server 162." Examiner notes the fig 6C and 10C at best show the same login account (common) and the same password (common20). Therefore, examiner assumes the Applicant is referring to the same account twice.

Applicant argues that "Tanaka does not enable an attached file to be separated from the electronic mail sent to user B and to be stored using a second password and a second user account, in order for user B to be able to retrieve the attached file separately upon request." Examiner notes that Tanaka is relayed upon to teach adding a second account and a second password. Arnold teaches the attached file separation and the retrieval of the attached file stored in a remote server. See the detailed office action below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1,5 and 6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "Log-in account adding means for adding a second user account and a second password different from the first user account and the first password, to the electronic mail" The specification does not specify "log-in account adding means for adding a second user account and a second password different from the first user account and the first password, to the

Art Unit: 2153

electronic mail". It does not clearly show how the second user account and second password different from the first user account and the first password is added to electronic mail. Examiner notes the fig 6C and 10C at best show the same login account (common) and the same password (common20). Therefore, examiner assumes the same account and password is used again.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1,3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (U.S. Patent Number 6,275,848, hereinafter "Arnold") in view of Tanaka et al (U.S. Patent Number 5,905,495, hereinafter "Tanaka" and further in view of Selgas et al, US PUB. 20020029275, hereinafter "Selgas". Arnold discloses method and apparatus for automated referencing of electronic information.

In referring to claims 1, 5, and 6 Arnold shows an electronic mail system for delivering electronic mail sent from a sender to the appropriate receiver (fig.1 and abstract), the system comprising:

attached file retrieving means for retrieving, in the case of a first store location

Art Unit: 2153

information, a first user account, and a first password being added to electronic mail sent from the sender, an attached file from a server of location shown by the first store location information using the first user account and the first password (Arnold, Figure 2, element 214 shows the step of submitting the attachment with a pointer (which inherently implies a store location information adding means); (col. 3, lines 46-66);

attached file separating step/means for separating, in the case of an attached file being added to electronic mail sent from the sender, the attached file from the electronic mail: Arnold, Figure 2, element 210 shows the step of detaching the attachment from the mail item (which inherently implies an attached file separating means. See col. 4, lines 6-45);

attached file transferring means for transferring the attached file separated from the electronic mail by the attached file separating means or retrieved from the server by the attached file retrieving means to a predetermined server using the user (second) account and password (second): Arnold, Figure 2, element 212 shows the step of storing the attachment on a remote site (which inherently implies an attached file transferring means (Access to the remotely-located attachment is controlled by an access list or other similar means for defining access rights. Preferably, only those recipients of the e-mail message have access to the Web site, and no other party has access rights to the attachment col. 3, lines 62-66), to enable a user to refer to the attached file transferred by logging in at the predetermined server; and

store location information adding means for adding second store location information indicating a location where the attached file transferred by the attached file transferring means is stored to the electronic mail: Arnold, Figure 2, element 214 shows the step of submitting the attachment with a pointer (which inherently implies a store location information adding means)

Art Unit: 2153

However, Arnold does not show log-in adding means adding a user account (second user account) and password (second password) to an electronic mail.

Nonetheless this feature is well known in the art and would have been an obvious modification of the system disclosed by Arnold as evidenced by Tanaka. In analogous art Tanaka discloses a communication system using electronic mail. Tanaka shows adding a user account and password to an outgoing electronic file (Fig. 13 and 16). Given these teachings a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Arnold so as to use both the password and the user ID for identification and a certification information (col. 37, lines 56-64). Tanaka further shows using a user account and password (figs 13 and fig. 16. Tanaka also discloses an outgoing file as an electronic mail addressed to a plurality of users with one or more user Ids col. 29, lines 64 to col. 30 line 15)

Arnold further shows a store location information corresponds to a store server, a store directory, a login account and a password to allow a receiver of the electronic mail to retrieve the attachment: "Another technical advantage is that the invention manages access to a remotely located attachment through use of an attachment access list. Only those individuals or entities named on the access list may have access to the attachment. Preferably only the recipients of the e-mail message are listed on the access list." (Arnold, col. 2, lines 56- 61)

Although Arnold and Tanaka show substantial features of the claimed invention, they do not show protecting a predetermined server from being attacked from outside of the network.

Art Unit: 2153

Nonetheless this feature is well known in the art and would have been an obvious modification of the system disclosed by Arnold and Tanaka as evidenced by Selgas.

In analogous art Selgas whose invention is about "...network access and to minimizing unauthorized interception of data and denial of network services." (§ 0002) discloses, a system of protecting a server from being attacked from outside of the network "Authentication services that securely authenticate client access to email, commerce, and other public and private network servers and services" (§ 0074; § 0177 and fig. 21). Given these teachings a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Arnold and Tanaka so as to use the attack protection system of Selgas in order to reduce the risk of service attacks and unauthorized access to critical network data (§ 0177).

In referring to claim 3, Arnold in view of Tanaka shows,

Not only store location information but also transfer method information indicating a transfer method used by the attached file transferring means are added to the electronic mail:

"...(5) placing the attachment on a remote site; and (6) inserting a pointer into the message, wherein the pointer is linked to the remote site. "(Arnold, col. 2, lines 36-38) A system that appends a pointer, which allows the user to retrieve the e-mail attachment, inherently implies the pointer includes the transfer method for retrieving said file

In referring to claim 4, Arnold in view of Tanaka shows,

The attached file separating means, attached file transferring means, and store location information adding means are implemented as exit programs on an electronic mail server:

Art Unit: 2153

Arnold, Figure 2 shows the attached file separating means, attached file transferring means, and store location information adding means are implemented ms exit programs on an electronic mail server.

Conclusion

5. **ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone numbers for the

Art Unit: 2153


organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR system. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YB

Art Unit 2153



GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100